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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,003	09/09/2003	Douglas S. Forrer	PTH-20404/08	2277

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GIFFORD, KRASS, GROH, SPRINKLE
ANDERSON & CITKOWSKI, PC
280 N OLD WOODARD AVE
SUITE 400
BIRMINGHAM, MI 48009

EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,003	FORRER, DOUGLAS S.	
	Examiner	Art Unit	
	Sunil Singh	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: at page 7, Pat. 3332357 is not to Heenan. Appropriate correction is required.
2. The abstract of the disclosure is objected to because the word "said" should be omitted. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 5,6,7,17,18, 24 and 25 are objected to because of the following informalities: in claims 6,18, 25, it is not clear what is included in the parentheses is part of the claim or not. Claim 7 calls for "reflective end wall... one piece" which is confusing because it is not clear how it relates to "at least one side wall having a reflective portion" called for in claim 1. It is unclear if claims 5, 6 should depend from claim 1 or claim 4. It is unclear if claims 17,18 should depend from 13 or 16. It is unclear if claims 24,25 should depend from claim 20 or 23. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heenan (US 3332327) in view of Coderre et al. (US 6325515) and applicant's admission of prior art .

Heenan discloses a reflective pavement marker (see Fig. 1) comprising a shell (12) having at least one side wall having a reflective portion, wherein said shell forms an interior cavity, said reflective portion having an inner surface partially defining said cavity; a reflective coating (70) covering said inner surface of said reflective portion; and a filler material (14) disposed within the interior cavity of said shell. The shell includes a top wall, side wall and reflective end wall having the reflective portion formed therein integrally. The reflective portion includes a plurality of integrally formed cube-shaped members arranged in a grid pattern (see col. 1 line 20). The reflective coating is a metal material (see col. 5 line 65).

Heenan discloses the invention substantially as claimed. However, Heenan lacks a bonding coating covering at least said reflective coating, wherein the bonding coating is a bonding primer such as an acrylic latex primer or a water based primer. Further, Heenan is silent about the shell being formed with the specific polymer called for in claims 1-6, 13-18, 20-25. Coderre et al. teaches a reflective marker having a bonding coating (28) covering at least the reflective coating (32) which covers cube corner reflective means (32), wherein the bonding coating is a bonding primer (see col. 3 line 56+). Applicant admits in his specification on pages 5-6, that the specific polymer called for in claims 1-6, 13-18, 20-25 is commercially available as Plexiglas V052.

It would have been considered obvious to one of ordinary skill in the art to modify Heenan to include the bonding coating as taught by Coderre et al. and to make the shell

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out of Plexiglas V052 as taught by applicant's admission of prior art so as to cover the reflective coating in order to protect the reflective coating from corrosion thus lengthening the life of the reflective marker and to have the shell sustain specified impact as well as have a specific transparency depending on its desired use.

The examiner would like to point to US Patent 4,234,265 as evidence that it is known to use Plexiglas for the shell of roadway reflectors (see col. 5 lines 34-42). Thus depending on the desired use, meaning potential impact the reflector would undergo (for example, if tractor trailers would be running over them then a high impact resistant would be needed, if cars only would be running over them then a less impact resistant would be needed etc.) and/or the desired optical features (meaning roadway with no street lighting would need more reflectivity than a roadway having street light), one skilled in the art would know what type of commercially available Plexiglas to use.

Another example is US Patent 4498733, wherein it is evidence that Plexiglas is used as the shell of roadway reflectors (see col. 8 lines 33+).

With regards to claims 20-25, the recited method steps are considered to be obvious in view of the combination as described above.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No.

6572305. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a reflective pavement marker.

8. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/453,366. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a reflective pavement marker.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh



Patent Examiner

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SS
2/20/04